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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,446	12/26/2001	Rick K. Southern	104981-4000	1727
28765	7590	08/23/2006		
WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006			EXAMINER	
			A, PHI DIEU TRAN	
			ART UNIT	PAPER NUMBER
			3637	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/034,446	<b>Applicant(s)</b> SOUTHERN ET AL.
	<b>Examiner</b> Phi D. A	<b>Art Unit</b> 3637
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b>		
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</b>		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
<p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>01 June 2006</u>.</p> <p>2a)<input type="checkbox"/> This action is <b>FINAL</b>.                            2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>		
<b>Disposition of Claims</b>		
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-3,5-7,10,12 and 14-20</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-3,5-7,10,12,14-20</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b>		
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p style="margin-left: 20px;">Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>		
<b>Priority under 35 U.S.C. § 119</b>		
<p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All    b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p style="margin-left: 20px;">1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p style="margin-left: 20px;">2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p style="margin-left: 20px;">3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>		
<p>* See the attached detailed Office action for a list of the certified copies not received.</p>		
<b>Attachment(s)</b>		
<p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____</p> <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date _____</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____</p>		

In view of the Appeal Brief filed on 6/1/06, PROSECUTION IS HEREBY REOPENED.

The claims are rejected as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is enabled for the adhesive having diisocyanate, not isocyanate

Applicant's specification page 1 lines 18-24 does not support the adhesive being isocyanate, the rejection is thus repeated above.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenway (2088238) in view of American Hardwood Information center (AHIC), Murray, and Searer (5570554).

Greenway shows a method of attaching solid hardwood floor planks (page 2, col 2 lines 24-30) to a concrete surface comprising the step of preparing solid wood floorboards having at least about 3 feet (page 1 col 1 lines 26-29) for attachment to the concrete surface(12) and securing the floorboards to the concrete with an adhesive (8), the step of allowing the adhesive to set (inherently so), the step of providing the floorboards with surface wormholes (6) and colors (inherently so), the step of applying adhesive to the concrete floor surface, preparing the concrete floor surface to be substantially flat, the floorboards being prepared away from the installation

site (inherently so as the boards formed elsewhere and then brought to the site for installation), the floorboard being provided with color (inherently so) and wormholes (6), nails (14) can be used in the wormholes (6) to fasten the board to the concrete at substantially right angle thereto through the board, the floorboards being prepared with surface features that include at least one of wormholes (6) and scratches, the adhesive is applied to provide an adhesive layer,

Greenway does not show the step of applying the floorboards to the concrete floor surface with at least one water resistant, water impermeable adhesive, and the step of nailing the boards to the concrete floor surface substantially at right angles thereto through the boards after the step of applying.

AHIC discloses the step of gluing floorboard to a concrete slab and then nailing the floorboard to the substrate (page 3 last paragraph and page 4 the Note section).

Searer shows a hardwood floor plank boards being nailed to the concrete floor surface substantially at right angles thereto through the boards.

Murray discloses an adhesive for mounting tiles to concrete floor (col 8 example 1), the adhesive being water resistant, water impermeable adhesive (col 7 lines 61-63), the adhesive able to fill voids or imperfections between construction material and having a rapid cure time (col 3 lines 45-49), the adhesive comprising moisture curable polyurethane-based composition, the adhesive comprising a prepolymer including a polyol and an isocyanate.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Greenway's method steps to show the step of applying adhesive and nails to secure the floorboard to the substrate as taught by AHIC, the step of providing an adhesive that is water resistant, water impermeable as taught by Murray, the step of nailing the boards to the

concrete floor surface substantially at right angles thereto through the boards as taught by Searer because securing the floorboards to the concrete floor with adhesive and nails would enable the secure fastenings of the structures as taught by AHIC, having the adhesive connecting the floorboard to the concrete being water resistant, water impermeable would enable the secure fastening of a flooring structure to a concrete substrate with the adhesive able to fill voids or imperfections between construction material, and having fast curing time as taught by Murray, and having nails going substantially at right angles thereto through the boards would further enhance the securing of the floorboards to the concrete as taught by Searer.

Greenway as modified shows all the claimed method steps.

Per claims 14-15, Greenway as modified further shows the adhesive comprising a prepolymer including a polyol and an isocyanate as taught by Murray.

Per claim 17, Greenway as modified shows the claimed method step of nailing nails into the surface features to hide the nails therein.

Per claim 18, Greenway as modified shows the claimed method of nailing the floorboards to the concrete through the adhesive layer.

Per claim 19, Greenway as modified shows the adhesive being allowed to set after the floorboards are nailed.

Per claim 20, Greenway as modified shows all the claimed method steps including the steps of nailing the boards to the concrete floor surface to hold the boards to the adhesive on the concrete surface as the adhesive sets.

3. Claims 3, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenway (2088238) in view of American Hardwood Information center (AHIC), Murray, and Searer (5570554).

Greenway as modified shows all the claimed method steps except for the step of preparing the concrete floor surface to be clean, dry, smooth, and low in surface moisture.

AHIC further discloses the steps of preparing the concrete floor surface to be clean, dry, smooth, low in surface moisture, and substantially flat before the application of adhesive (page 1, the section of "Protect the Flooring" states the concrete should be completely dry which is taken as the concrete having low moisture surface).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Greenway's modified method steps to show the step of preparing the concrete floor surface to be clean, dry, smooth, low in surface moisture because it would enable the proper application of adhesive between the floorboards and concrete surface as taught by AHIC.

4. Claims 5-7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenway (2088238) in view of American Hardwood Information center (AHIC), Murray, and Searer (5570554).

Greenway shows hardwood floor planks (page 2, col 2 lines 24-30) of at least about 3 feet (page 1 col 1 lines 26-29) being attached onto a concrete surface and securing it with an adhesive, the floor having varying thickness at the grooves, the floorboard being provided with color (inherently so) and wormholes (6), nails (14) can be used in the wormholes (6), the floorboards are of varying thickness (at the grooves).

Greenway does not show the adhesive being water resistant, water impermeable adhesive, nails that extend at right angles to the concrete floor surface through the boards, through the adhesive and into the concrete floor surface.

AHIC discloses attaching floorboards to concrete surface by adhesive and nails (page 3 last paragraph and page 4 the Note section).

Searer shows a hardwood floor plank boards being nailed to the concrete floor surface at right angles thereto through the boards.

Murray discloses a water resistant, water impermeable adhesive (10) securing a flooring surface to a concrete surface.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Greenway to show the adhesive being water resistant, water impermeable adhesive as taught by Murray, nails that extend at right angles to the concrete floor surface through the boards as taught by Searer, nails extending through the adhesive and into the concrete floor surface as taught by AHIC because it enhances the secured fastening of the floorboards to the concrete surface.

#### *Response to Arguments*

5. Applicant's arguments with respect to claims 1-3, 5-7, 10, 12, 14-20 have been considered but are moot in view of the new ground(s) of rejection.

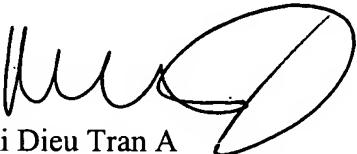
#### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different concrete and floorboards attaching methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

8/21/06